

REMARKS/ARGUMENTS

By the present amendment, Applicant has amended independent Claim 1, which is the only claim remaining for consideration, Claims 2-7 having been cancelled.

Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

In the recent Office Action the Examiner rejected Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Bonnett (US 5,069,554) in view of Bilotti (US 5,339,748), Petriekis et al. (US 6,609,636) and Carter (US 6,729,758).

The basic reference to Bonnett discloses a tablecloth disposal system. In the most recent Office Action, the Examiner states regarding Bonnett:

“Bonnett teaches a circular table cloth (fig 3, #7) convertible to a garbage bag (col. 1, lines 6, 12), comprising a flexible panel (col. 1, line 8) closing over a table top (fig 1, #2) and at least two handles attached to said flexible panel proximate said edge (fig 3, #3) whereby [the] tablecloth converts into a garbage bag (fig 6) by pulling on the draw string cinch system (fig 3, #3), said garbage bag being carried by said handles to a place for disposal (Office Action, p. 3, lines 7-12, emphasis added).”

However, contrary to the Examiner's description of Bonnett, the tablecloth of figs. 1-2, and the circular tablecloth of fig. 3 are flat, flexible sheets that sit on the top of a table 8, and have raised peripheral edges 2 to surround the central flat surface 1 and prevent a spilled beverage or liquid L from running off the edge of the table. Cinches 3, which are eventually used to form the sheet into a bag-like configuration, may also be used to further contain the spilled liquid on the tabletop, but nowhere in Bonnett does it indicate that the tablecloth T is to be "closed" over the tabletop, as the Examiner indicates. In fact, it is quite clear that if the tablecloth of Bonnett were to be closed over the tabletop, the device would no longer operate in the manner intended, namely, the raised peripheral edges 2 would not be in position to prevent a spilled liquid from running off of the table.

Thus, when the Examiner states that it would have been obvious "to have provided an elastic band in the table cover of Bonnett in order to provide a tight fit over the table top as taught by Bilotti (Office Action, p. 4. lines 2-3)", Applicant must strenuously disagree. In this regard, while Bilotti does show a circular tablecloth with an elastic band 14 to provide a relatively snug fit of a tablecloth to a tabletop, to provide such an elastic band in the tablecloth T of Bonnett would destroy Bonnett's invention. If the Bonnett tablecloth were to include such an elastic band, the tablecloth would either not lay flat on the tabletop as the Bonnett device is intended to be used, or in the modification contemplated by the Examiner with the elastic band providing a "tight fit" over the tabletop, the peripheral edges 2 would be drawn over the edges of or beneath the tabletop and would not be in place to prevent

spilled liquid run-off. In either scenario, the Bonnett tablecloth would no longer be fit for its intended purpose. And, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See MPEP§ 2143.01(V). Thus, there is no proper motivation or incentive to modify Bonnett according to the teachings of Billotti in the manner urged by the Examiner, absent that which is present in Applicant's own disclosure. For at least this reason, the rejection of Claim 1 under 35 U.S.C. § 103(a) based on Bonnett, Bilotti, Petriekis et al. and Carter is improper and should be withdrawn.

The patent to Carter discloses an insulated container for a beer keg comprised of a bag 1 having a fabric shell 7 and an inner liner 9 sandwiching a suitable flexible insulating material 11 therebetween. The bag 1 has drawstrings 3 and handles 5 that may be made of rope or a fabric such as nylon. Handles 5 are used to raise the bag 1 upwardly so that it completely covers the beer keg 13, and then drawstrings 3 are drawn tight to completely cover and insulate the keg 13. The Examiner believes that it would have been obvious "to provide handles in Bonnett that are attached to the peripheral edge of the bag in order to provide ease of transporting the contents (col. 1, lines 28-31) as taught by Carter (Office Action, p. 5, lines 4-6)." Again, Applicant disagrees with the Examiner's conclusion. As before, there is clearly no suggestion or incentive in the applied references to Bonnett and Carter to modify the Bonnett tablecloth disposable system as urged by the Examiner, absent

the teachings of Applicant's own disclosure. Applicant admits that there are many things that have handles, and plastic handles for that matter, but that doesn't mean that it would have been obvious to modify the Bonnett patent to have handles fixedly attached to the peripheral edge if there is no teaching or suggestion in the prior art to make the modification. It is unclear from the Examiner's rejection if he is suggesting that it would have been obvious to replace the cinch piece 3, which becomes handles when converting the tablecloth to a garbage bag, or if he is suggesting that handles be fixedly attached to the peripheral edge of Bonnett in addition to cinch piece/handle 3. In either case, it would not be obvious to make such a modification. If cinch piece 3 were to be removed, then raised peripheral area 2 would not function properly, since cinch 3 provides stability to the raised peripheral area and allows it to be uniformly raised by the cinch 3 to provide further containment of a beverage spilled on the centrally located flat area. And, it simply would not be practical to add handles to the peripheral edge 2, since cinch pieces 3 already act as handles and perform that function. It simply would not have been obvious. Therefore, for at least this additional reason, the rejection of Claim 1 under 35 U.S.C. § 103(a) based on Bonnett, Bilotti, Petriekis et al. and Carter is improper and should be withdrawn.

Obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). What is necessary is

a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. The showing must be clear and particular. Broad statements of conclusion regarding the teaching of multiple references and a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis". *In re Dembiczak*, 175 F.3rd 994, 50 USPQ2d 1614 (Fed.Cir. 1999). In the present application, the only teaching or suggestion of providing an elastic band surrounding the peripheral edge of the tablecloth of Bonnett, and of providing fixedly attached handles on the expandable peripheral edge stems from Applicant's own disclosure. There is no teaching, suggestion or incentive in the applied references that would have led one of ordinary skill in the art to combine the teachings of Bonnett with those of Bilotti, Petriekis et al. and Carter to arrive at Applicant's claimed invention, in the manner urged by the Examiner. It is therefore Applicant's conclusion that the combined teachings of Bonnett, Bilotti, Petriekis et al. and Carter fail to establish a *prima facie* case of obviousness, and as noted above the rejection of Claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

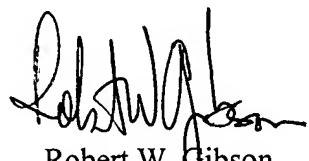
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The claims in this application have been revised to more particularly define Applicant's unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the above-noted reasons is respectfully requested.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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